REMARKS

Favorable reconsideration and allowance of the subject application are respectfully

requested in view of the following remarks.

Summary of the Office Action

Claims 1-3, 5, 6, 8, 10, 12, 14 and 15 stand rejected under 35 U.S.C. §102(b) as being

anticipated by *Shaughnessy et al.* (U.S. Patent No. 5,075,787) or *Ng et al.* (U.S. Patent No.

5,138,465).

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Shaughnessy*

et al. or *Ng et al.* in view of the related art section of the present application.

Claim 4 is allowed.

Claims 9, 11 and 13 stand objected to as being dependent upon a rejected base claim, but

would be allowable if rewritten in independent form.

Summary of the Response to the Office Action

Applicants propose to amend claims 1, 5, 8 and 15 by this amendment. Claims 1-15 are

currently pending and under consideration.

The Disposition of the Claims

Applicants appreciate the Examiner's allowance of claim 4 and the Examiner's indication

that claims 9, 11 and 13 would be allowable if rewritten in independent form.

In addition, while Applicants agree that these claims are allowable and patentably

distinguish over the prior art, Applicants respectfully do not acquiesce that patentability resides

only in the features expressed in paragraph 7 of the Office Action, nor that each and every

feature recited in the claims is required for patentability.

Further, Applicants respectfully submit that claims 1-3, 5-8, 10, 12, 14 and 15 are also allowable for at least the following reasons.

Claim Rejections Under 35 U.S.C. §102(b) and §103(a)

Claims 1-3, 5, 6, 8, 10, 12, 14 and 15 stand rejected under 35 U.S.C. §102(b) as being anticipated by *Shaughnessy et al.* or *Ng et al.* Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Shaughnessy et al.* or *Ng et al.* in view of the related art section of the present application. To the extent that these rejections might be applied to the claims, as newly-amended, they are respectfully traversed for at least the following reasons.

Applicants respectfully submit that *Shaughnessy et al.* or *Ng et al.* does not anticipate the recited claims because *Shaughnessy et al.* or *Ng et al.* does not disclose all of the features of these claims. For instance, it is respectfully submitted that *Shaughnessy et al.* or *Ng et al.* does not teach or suggest the claimed combinations as set forth in independent claims 1 and 8, as newly-amended, including at least "to render an altered image different from the original image at the time of scanning of the original image." Applicants further respectfully submit that *Shaughnessy et al.* or *Ng et al.* does not teach or suggest the claimed combination as set forth in independent claim 5, as newly-amended, including at least "to render an altered image different from the original image at the time of inputting of the original image," and the claimed combination as set forth in independent claim 15, as newly-amended, including at least "to render an altered image different from the original images at the time of scanning the original images."

The disclosure of the present application includes a feature in which the scanned or inputted original image including the inhibit image is rendered to have an altered image different from the original image at the time of scanning or inputting of the original image, then the

altered image data is outputted. Thus, the scanned original image including the inhibit image is not stored in a memory during the image processing.

In contrast to Applicants' claimed combinations, as shown in FIG. 5a, *Shaughnessy et al.* instead discloses that the original image scanned by the CCD (81) is stored in a page buffer first (75c). Then, the scanned and stored original image of *Shaughnessy et al.* is detected whether it has loop boundary (75b). Therefore, a copy inhibit image of *Shaughnessy et al.* is stored in the page buffer (75c) and accessed from the page buffer (75c).

Similarly, *Ng et al.* discloses at FIG. 5 that the original image scanned by the CCD (81) is stored in a page buffer first (75c). Then, the scanned and stored original image of *Ng et al.* is detected whether it has loop boundary (75b). Therefore, a copy inhibit image of *Ng et al.* is stored in the page buffer (75c) and accessed from the page buffer (75c). Hence, Applicants respectfully submit that *Shaughnessy et al.* or *Ng et al.* fails to teach or suggest the claimed combinations as set forth in independent claims 1 and 8, as newly-amended, including at least "to render an altered image different from the original image at the time of scanning of the original image." Applicants further respectfully submit that *Shaughnessy et al.* or *Ng et al.* does not teach or suggest the claimed combination as set forth in independent claim 5, as newly-amended, including at least "to render an altered image different from the original image at the time of inputting of the original image," and the claimed combination as set forth in independent claim 15, as newly-amended, including at least "to render an altered image different from the original images at the time of scanning the original images."

M.P.E.P. § 2131 states "[t]o anticipate a claim, the reference must teach every element of the claim." Applicants respectfully submit that since *Shaughnessy et al.* or *Ng et al.* does not teach or suggest all of the features of independent claims 1, 5, 8 and 15, as newly-claimed,
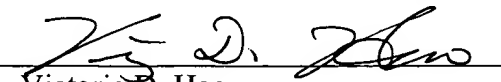
Shaughnessy et al. or *Ng et al.* does not anticipate claims 1, 5, 8 and 15. Further, since claims 2, 3, 6, 7, 10, 12 and 14 depend from claims 1, 5 and 8, it is respectfully submitted that *Shaughnessy et al.* or *Ng et al.* also does not anticipate claims 2, 3, 6, 7, 10, 12 and 14. Accordingly, withdrawal of the rejection of claims 1-3, 5, 6, 8, 10, 12, 14 and 15 under 35 U.S.C. §102(b) and withdrawal of the rejection of claim 7 under 35 U.S.C. §103(a) are respectfully requested.

Conclusion

In view of the foregoing, Applicants respectfully request the entry of this Amendment to place the application in clear condition for allowance or, in alternative, in better form for appeal. Applicants also respectfully request the Examiner's reconsideration and reexamination of the application and the timely allowance of the pending claims. Should there remain any questions or comments regarding this response or the application in general, the Examiner is urged to contact the undersigned at the number listed below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,
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